

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of
Christian STAPPER, et. al.

Examiner: Kamal A. SAEED

Application No.: **10/788,996**

Art Unit: 1626

Filed: **February 27, 2004**

Title: **CYCLOALKYLMETHOXY-
SUBSTITUTED ACETIC ACID
DERIVATIVES, PROCESSES FOR
THEIR PREPARATION AND THEIR
USE AS PHARMACEUTICALS**

RESPONSE TO ELECTION/RESTRICTION REQUIREMENT

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

This is in response to the Office Action comprising a restriction requirement dated August 16, 2006 that had a one (1) month period for response. This would result in a due date for response of September 16, 2006 and therefore the election and arguments set forth herein are timely filed. Applicants respectfully request reconsideration of this application in view of the following remarks.

REMARKS

In the Office Action, the Examiner requires restriction under 35 U.S.C. § 121 among the following Groups:

Group I. Claims 1-7, 16, and 24-26, drawn to compounds of formula (I) and compositions classified in various subclasses of classes 514, 546 and 548.

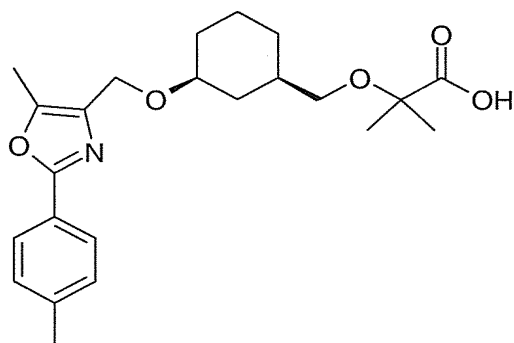
Group II. Claims 8-14 and 17-22, drawn to a method of use of the compounds of formula (I) classified in various subclasses of class 514.

Group III. Claim 15, drawn to a process of preparing compositions of formula (I) classified in various subclasses of classes 514, 546 and 548.

as set forth in the above-referenced Office Action at page 2. In addition, the Examiner also requires election of a single species of the compounds of formula (I) under 35 U.S.C. § 121. including an exact definition of each substitution on the base molecule of formula (I) wherein a single variable at each substituent, group or moiety is selected.

Applicants respectfully traverse the restriction and election requirements for the following reasons. However, in order to be fully responsive, Applicants provisionally elect, with traverse, the subject matter of Group I, claims 1-7,16,21, and 24-26, for prosecution on the merits. In addition, Applicants provisionally elect, with traverse, the compound of Example 8a disclosed on page 89 of the application, i.e.

2-[(1R,3S)-3-(5-Methyl-2-p-tolyloxazol-4-ylmethoxy)cyclohexylmethoxy]-2-methylpropionic acid as represented structurally below.

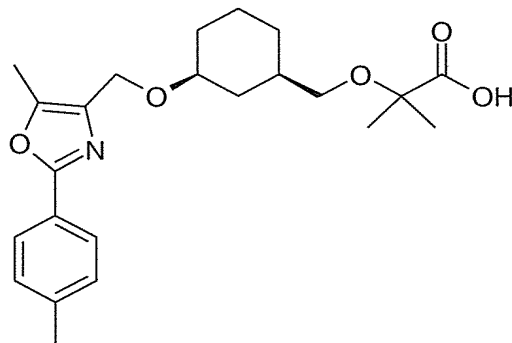


The Examiner indicates that “upon the election of a single compound, the Office will review the claims and disclosure to determine the scope of the independent invention encompassing the elected compound (compounds which are so similar thereto as to be within the same inventive concept and reduction to practice). It is also asserted that the scope of an independent invention will encompass all compounds within the scope of the claim which fall into the same class and subclass as the elected compound and this, may also include additional compounds, which fall in related subclasses. Examination will then proceed on the elected compound AND the entire scope of the invention encompassing the elected compound as defined by common classification. Moreover, a clear statement of the examined invention, as defined by those class(es) and subclass(es) will then be set forth in the first action on the merits. Therefore, in view of this assertion, Applicants reserve the right to supplement the Examiners list of inventive compounds with claims falling within the generic concept of the elected species.

Applicants respectfully traverse the restriction and election requirements for at least the following reasons.

For a restriction requirement to be proper, the Examiner must show that a serious burden exists if all claims are required to be examined together. M.P.E.P. § 803 (8th ed., August 2001). However, the Examiner has not shown that there would be a serious burden to examine the claims of

Groups I-III together. Further, Applicants respectfully submit that examining all of the claims together would not impose a serious burden, because all claims recite a compound within the scope of formula (I).



While “a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation of the need for separate classification,” among other things, id., the Examiner has not shown entirely separate classification. Quite to the contrary, Groups I and III are listed as falling within classes 514, 546, and 548; and Group II is also listed as falling within class 514 Office Action, page 2. Therefore, by examining the claims of Group I and in the cited classes, the claims of Group II and III could also be examined. Accordingly, Applicants respectfully request that the Examiner withdraw the restriction and election requirements and examine Groups I-III together. The Should the Examiner have any additional questions or concerns, he is earnestly encouraged to contact the undersigned attorney listed below, Applicant, by his attorney, thanks Examiner Saeed for his prompt attention to this matter.

Respectfully submitted,

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